

REMARKS

Claims 1-10 are pending. The Examiner rejected claims 1-7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,432,758 ("Sone"). Claims 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of the Applicant's admitted prior art.

I. The § 102 Rejections

Claim 1, as amended, recites a transducer transitioning between a transfer media of a jumper cable and an electronic data transfer protocol of an integrated circuit mounted on a substrate. The transducer includes a base mountable on the substrate, and an input/output (I/O) lead configured to directly contact an I/O lead of the integrated circuit mounted on the substrate. Applicant restates the argument presented in response to the previous office action, that Sone does not teach leads "configured to directly contact an I/O lead of the integrated circuit mounted on the substrate", on which the base of the transducer is mounted, as recited in claim 1.

The Examiner states that the claim requires the I/O lead to be configured to contact an I/O lead of a integrated circuit, and Sone would read on applicant's claims "because to perform a function is not a positive limitation, but only requires the ability to so perform" and "does not constitute a limitation in any patentable sense." Applicant respectfully disagrees.

As per § 2173.05(g) of the MPEP, "there is nothing inherently wrong with defining some part of an invention in functional terms. ... A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." A limitation, although functional, may be perfectly acceptable because it sets definite boundaries on the protection sought. The limitation of claim 1 recites "an input/output (I/O) lead configured to directly contact an I/O lead of the integrated circuit mounted on the substrate", and thereby more particularly describes the invention, in that the limitation requires not only a lead, but a lead configured in a particular manner, *i.e.* to directly contact an I/O lead of the integrated circuit. Even a cursory examination of Sone's leads 22 and 24 shows that they are not able to provide the recited function. Therefore, Sone fails to disclose such an I/O lead, and accordingly fails to disclose each and every element of claim 1.

Applicant also restates an argument made in response to the previous office action, that the transducer disclosed by Sone is an electro-acoustic transducer that creates an acoustic signal

in response to an electric signal, which is not a transducer as that term is understood in the field of computer design. In response to applicant's argument that Sone does not show the term transducer as described in the specification, the Examiner states that "Applicant misinterprets the principle that claims are interpreted in the light of the specification." The Examiner further states that "although these definitions are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations."

Applicant respectfully disagrees. As stated in § 2173.05(a) of the MPEP, "when the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art." Applicant submits the specification clearly defines the term transducer as that term is understood in the field of computer design (see Background, page 1, lines 17-19). In any event, amendments to claim 1 to specify a transducer "transitioning between a transfer media of a jumper cable and an electronic data transfer protocol of an integrated circuit mounted on a substrate" ought to address the Examiner's concern in this regard. Sone fails to disclose a transducer of this nature, and accordingly fails to teach each and every element of claim.

Applicant submits that for at least the reasons stated above, claim 1, and claims 2-7 that depend from claim 1, are allowable over Sone.

Claim 2 is allowable for the following additional reason. Claim 2 recites the transducer of claim 1, "wherein the transducer I/O lead is configured to electrically connect to the integrated circuit I/O lead independently of any electrically conductive path of the substrate." Sone teaches a transducer having leads connected to conductive paths on the transducer, which in turn are electrically connected to a printed board. Accordingly, Sone teaches away from a transducer having a lead configured to electrically connect to an integrated circuit I/O lead independently of any electrically conductive path of the printed board (substrate), as recited in claim 2.

Applicant submits claims 1-7 are patentable over Sone for at least the reasons stated above.

II. The § 103 Rejections

Claims 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sone in view of the applicant's admitted prior art. The Examiner states that applicant's admitted prior art discloses the use of transductional devices that can be opto-electronic devices or electronic devices, and that it would have been obvious to one with ordinary skill in the art to modify the transducer of Sone by including transductional devices that can be opto-electronic devices or electronic devices as taught in applicant's admitted prior art to provide efficient transmission of data.

Applicant respectfully disagrees. Sone is clearly directed toward an electro-acoustic transducer. At column 2, lines 33-42, Sone states "[i]t is an object of the invention to provide an electro-acoustic transducer that realizes a simplification of the base portion and that permits a miniaturized or thin construction without the deterioration of the acoustic characteristics. It is another object of the present invention to provide an electro-acoustic transducer that realizes a simplification of the core provided in the base portion." The Examiner states that "it would have been obvious to one with ordinary skill in the art to modify the transducer of Sone by including transductional devices that can be opto-electronic devices or electronic devices as taught in the Applicant's admitted prior art to provide efficient transmission of data", yet fails to provide any reason why that would be obvious. There is no suggestion, explicit or implicit, in Sone to modify the electro-acoustic transducer of Sone in this manner. Sone is clearly directed toward an electro-acoustic transducer. Further, it is unclear how or if the electro-acoustic transducer of Sone could be modified by including opto-electronic or electronic devices.

For at least the reasons stated above in reference to claim 1, applicant submits that Sone fails to disclose all of the elements of the transducer recited in claim 1, from which claims 8-10 depend, and accordingly claims 8-10 are allowable. Additionally, Sone does not, in combination with applicant's admitted prior art, teach or suggest each and every element of the transducer recited in claims 8-10, and accordingly the claims are patentable over Sone in view of applicant's admitted prior art.

Applicant filed an Information Disclosure Statement on February 1, 2002, and requests that the Examiner return an initialed copy of the Form-1449 to indicate that the references have been considered.

Applicant : Schelto Van Doorn
Serial No. : 09/574,647
Filed : May 18, 2000
Page : 6

Attorney's Doc No.: 12754-064001 / 00P7629

Attached is a marked-up version of the changes being made by the current amendment. Applicant asks that all claims be allowed. Applicant believes that no fees are due for the filing of this Response. However, if any fees are due, the Commissioner is authorized to apply any charges to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 5/31/02

David J. Goren
David J. Goren
Reg. No. 34,609

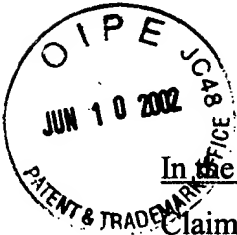
Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50089380.doc

Applicant : Schelto Van Doorn
Serial No. : 09/574,647
Filed : May 18, 2000
Page : 7

Attorney's Doc. No.: 12754-064001 / 00P7629

COPY OF PAPERS
ORIGINALLY FILED



Version with markings to show changes made

In the claims:

Claim 1 has been amended as follows:

1. (Amended) A transducer transitioning between electronic data transfer protocols of a jumper cable and an integrated circuit mounted on a substrate, comprising:
a base mountable on [a]the substrate, and
an input/output (I/O) lead configured to directly contact an I/O lead of [an] the integrated circuit mounted on the substrate.

RECEIVED
JUN 20 2002
TECHNOLOGY CENTER 2800